

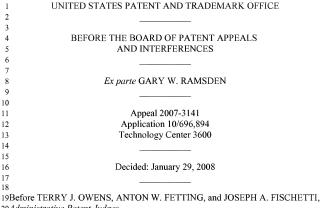
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271/0 7590 PATENT ADMINISTRATOR KATTEN MUCHIN ROSENMAN LLP 1025 THOMAS JEFFERSON STREET, N.W. FAST LOBRY SILITE 700			EXAM	EXAMINER	
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The time period for reply, if any, is set in the attached communication.



20Administrative Patent Judges.

21FETTING, Administrative Patent Judge.

- DECISION ON REQUEST FOR REHEARING 22 23
- The Appellant filed a REQUEST FOR REHEARING PURSUANT TO 37 24 25C.F.R. § 14.52 on December 10, 2007.
- 26 The Examiner rejected claims 77, 79, and 80. We affirmed these rejections in 27our October 10, 2007 Decision. The Appellant seeks reconsideration of the 28decision to affirm these rejections.

1 We CONSIDER the arguments in the REQUEST FOR REHEARING, and 2DENY the REQUEST FOR REHEARING.

3 ISSUES

4 The issue pertinent to this request is whether the Appellant has sustained his 5burden of showing that we misapprehended the art or the claims and thus erred in 6sustaining the rejections of claims. 37 C.F.R. § 41.52(a).

7 ANALYSIS

- 8 We found in our decision that claims 77, 79, and 80 were unpatentable under 935 U.S.C. § 103(a) over the prior art (Decision 12).
- The Appellant argues that (1) the Board failed to find that the prior art 11described a printer for printing a shipping receipt for an amount including at least 12the cost of delivering said parcel or envelope to said destination via the delivery 13option chosen by said customer (Request 2); (2) the Board failed to find the level 14of skill in the art at the time of the invention (Request 3); and (3) the Board 15misconstrued the calculation of cost in FF 02 of the Decision (Request 4).
- 16 Argument (1) the Board failed to find that the prior art described a printer for 17 printing a shipping receipt for an amount including at least the cost of delivering 18 said parcel or envelope to said destination via the delivery option chosen by said 19 customer
- 20 Apparently, the Appellant, after admitting that Pusic does describe a printer, 21contends that the Board failed to make a finding that the printer printed a receipt 22(Request 2: Bottom ¶, fifth to seventh lines).

- 1 However, the Appellant fails to explain, and we do not see how the finding of 2this element affects the Board's decision affirming the rejection of claim 77.

 3Regarding the teachings of Hsieh and Pusic, the Appellant does not contend that 4we misapprehended Appellant's arguments in the Brief.
- 5 As the Decision (p. 9) states, the Appellant only contended that Hsieh does not 6compute costs based on the destination; that Pusic fails to describe a selectable 7delivery option; that Hsieh teaches away from claim 77 because it is limited to 8computations using two variables and there would be no reasonable expectation of 9success in achieving the limitations of claim 77 for similar reasons; and there is no 10suggestion to combine Hsieh and Pusic. The Appellant concluded that the 11combination of Hsieh and Pusic do not allow for different delivery options or are 12limited to delivery options whose pricing is independent of destination. We made 13findings as to each of these contentions. The Appellant does not dispute this.
- 14 Thus, the Appellant did not disagree that Pusic disclosed printing a receipt *per* 15se. The Examiner had made such a finding (Answer 4). We were not placed in a 16position to consider the teachings of Hsieh or Pusic regarding printing of a receipt 17per se with respect to claim 77, only the contents of what was printed. The 18Examiner's finding that a receipt was printed was uncontested.
- 19 Argument (2) the Board failed to find the level of skill in the art at the time of the invention
- 21 The Appellant contends that the Office's guidelines require a finding of the 22 level of ordinary skill (Request 3). Again, the Appellant is making a contention

1not made in the briefs, and has not argued that he did so, so we were not placed in 2a position to consider this argument.

- The Appellant admits, however, that we did make such findings in FF 10 4(Request 3:Bottom ¶, second line). Further, the absence of specific findings on the 5level of skill in the art does not give rise to reversible error where the prior art itself 6reflects an appropriate level and a need for testimony is not shown. *See Okajima* 7v. *Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).
- 8 Argument (3) the Board misconstrued the calculation of cost in FF 02 of the
 9 Decision
- 10 The Appellant contends that our construction of the limitation that a cost for 11mailing a parcel or envelope to a destination is a function of a weight and a 12selected delivery option is improper (Request 4). The Appellant contends that the 13Specification supports a construction in which cost is also a function of destination. 14(Request 4).
- 15 We begin by pointing out that the Examiner did not make a construction as to 16this limitation, and therefore, ours was the first construction placed in the record.
- 17 In our decision, we found that the plain reading of the limitation meant that the 18 function was one of the two variables weight and delivery option (Decision 5: FF 1902). We find that the Appellant has not shown how this construction affects our 20 Decision to affirm the Examiner, because the Appellant has not shown a nexus 21 between this construction and an argument in favor of patentability. We also find 22 that the Appellant has not demonstrated that such a construction does no more than 23 reflect breadth of the claim as drafted. The Appellant has pointed to no

Ilexicographic definition of the claimed function, nor how having the function be 2independent of destination would be incompatible with the invention.

3 For the above reasons we are not convinced of misapprehension of the issues 4leading to reversible error in our decision. Accordingly, the Appellant's request 5for rehearing is denied,

6 DECISION

- 7 To summarize, our decision is as follows:
- We have considered the REOUEST FOR REHEARING
- We DENY the request that we reverse the Examiner as to claims
- The rejection of claims 77 and 80 under 35 U.S.C. § 103(a) as unpatentable over Hsieh and Pusic remains affirmed.
- The rejection of claim 79 under 35 U.S.C. § 103(a) as unpatentable over
 Hsieh, Pusic, and Tateno remains affirmed.

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REHEARING DENIED

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